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PATENT
Attorney Docket No.: DB000575-012

4/10/03

*Petition
Req for
Reconsideration*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Keeth, et al.)
Serial No.: 09/885,217) Examiner:
Filed: 20 June 2001) Art Unit:
Entitled: 256 MEG DYNAMIC RANDOM ACCESS MEMORY

REQUEST FOR RECONSIDERATION

To: Assistant Commissioner for Patents
Washington, D.C. 20231

I. INTRODUCTION

Applicants request reconsideration of the Office of Petitions' Decision ("Decision") (copy attached) dismissing Applicant's Petition to Grant a Filing Date ("Petition") (copy attached). The Decision contradicts the United States Patent and Trademark Office's ("USPTO") past actions and the applicable rules, laws, and procedures. The above-identified Application ("217 Application") complies with all USPTO rules and procedures and should be granted a filing date of 20 June 2001.

II. BACKGROUND

The '217 Application was filed on 20 June 2001 as a divisional of application serial number 09/620,606 ("606 Application"). The '606 Application was a divisional of application 08/916,692 ("692 Application"). As filed, the '692 Application contained claims 1-80. The '606 Application's preliminary amendment (filed with the Application) added claims 81-465.

The '217 Application was filed with a copy of the specification from the '692 Application and a preliminary amendment. The '217 Application's preliminary amendment cancelled claims 1-222, 238-246, and 251-465. Thus, the '217 Application contained nineteen (19) claims.

A copy of the preliminary amendment from the '606 Application was inadvertently omitted from the '217 Application. Applicants now rely on the text printed on the Utility Patent Application Transmittal stating, "For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference." Applicants submitted a copy of the declaration that was filed in the '692 Application ("Declaration"). Therefore, Applicants complied with this statement.

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III. BASIS FOR OFFICE OF PETITION'S DECISION

The Decision dismissed the Petition because the Declaration filed in the '217 Application "does not execute a subsequently-filed amendment. What was incorporated, therefore, is only the specification, claims, and drawings from [the '692 Application.]" Decision, page 2. The Decision cites to no legal support for this rule or conclusion.

IV. DISCUSSION

A. There Was No Requirement For A New Declaration In The Parent Application

Applicants are without any understanding for the legal rationale underlying the Decision to deny the '217 Application a 20 June 2001 filing date because the Declaration did not execute a subsequently filed amendment. The '606 Application was filed with a copy of the Declaration from the '692 Application without any problems. Like the '606 Application, the '217 Application contained no new inventors or new matter and, therefore, a new declaration is not required for it.

MPEP § 201.06(c) clearly establishes that no new declaration is needed so long as the continuation or division does not contain any new inventors or new matter, and the divisional is filed with a copy of the executed declaration filed in the prior application. Additionally, MPEP § 714.01(e) states that

[w]here an application filed under 37 CFR 1.53(b) is filed without a signed oath or declaration and such application is accompanied by an amendment, that amendment is considered a part of the original disclosure. The subsequently filed oath or declaration must refer to both the application and the amendment.

MPEP § 714.01(e) (8th Edition), MPEP § 714.09 (7th Edition, Latest Revision). The '606 Application was filed with a preliminary amendment and a copy of the declaration from its parent. Therefore, the declaration filed in the parent case did not need to refer to both the application and the amendment because it was not filed subsequent to the amendment.

B. Declaration In Present Application Is Properly Executed

Applicants submitted a copy of the Declaration with the filing of the '217 Application in compliance with 37 C.F.R. 1.63(d)(1). No new declaration is needed for the claims that are included in the preliminary amendment, which was filed with the '217 application. This preliminary amendment did not add any new claims. It merely cancelled claims from the parent application. Hence, this preliminary amendment is covered by the Declaration that was filed in the parent application, a copy of which was filed with the '217 application.

C. Parent Application Is Properly Incorporated

Finally, Section 201.06(c) of the 7th Edition, Latest Revision February 2000, in effect when the '217 Application was filed, contains one paragraph on incorporation by reference:

. . . [A]n applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are 'hereby incorporated by reference.' The statement may appear in the specification or in the application

transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition.

MPEP § 201.06(c) (7th Edition, Latest Revision Feb. 2000). The final subsection of MPEP, §201.06(c) entitled "EXAMINATION," contains several relevant statements:

If the examiner finds that pages of the specification or drawings figures described in the specification are missing and the application is a continuation or divisional application filed under 37 CFR 1.53(b) using a copy of the oath or declaration filed in the prior application under 37 CFR 1.63(d), the examiner must check to determine whether the continuation or divisional application, as originally filed, includes a statement incorporating by reference the prior application(s). The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit applicant to amend the continuation or divisional application to include *any subject matter in the prior application(s) without the need for a petition.*

MPEP § 201.06(c) (7th Edition, Latest Revision) (emphasis added). The USPTO form Utility Patent Application Transmittal contains the statement, "The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts."

The 7th Edition, Latest Revision of the MPEP, allows for the inclusion of a statement incorporating by reference the entire specification of the parent application into a continuation or divisional application. "An amendment filed before the first Office Action, but not filed along with the original application, does not enjoy the status of part of the original disclosure[,] thus, implying that a preliminary amendment filed with the original application does enjoy the status of being part of the original disclosure. MPEP § 714.09 (7th Edition, Latest Revision). Therefore, because Applicants correctly incorporated by reference the parent application, and because the parent application was filed simultaneously with a preliminary amendment, the preliminary amendment was incorporated.

Section 201.06(c) 7th Edition does not contain a statement prohibiting incorporation by reference of information needed to grant a filing date.

D. Alternatively, The Amendment Should Not Have Been Entered

If the USPTO determines that the Applicants failed to properly incorporate the preliminary amendment from the '606 Application, then the '217 Application's preliminary amendment should have been denied entry and the '217 Application should have been granted a filing date as of 20 June 2001. The 7th Edition, Latest Revision of the MPEP, provides that "an amendment filed after the filing date of an application canceling all of the claims . . . is regarded

as non responsive and should not be entered" MPEP § 711.01 (7th Edition, Latest Revision). *See also* MPEP § 714.19(H) (7th Edition, Latest Revision) (identifying this type of amendment as one that should be denied entry). Although the '217 Application's preliminary amendment was not filed "after the filing date" of the '217 Application, it was within the USPTO's discretion to disregard the preliminary amendment and grant the '217 Application a 20 June 2001 filing date. *See Exxon Corp. v. Phillips Petroleum Co.*, 265 F.3d 1249 (Fed. Cir. 2001), MPEP § 714.20 (7th Edition, Latest Revision). Such a decision by the USPTO would have been in greater harmony with the USPTO's present policy (as discussed below).

E. USPTO Recent Policy Posting

Applicants would also like to direct attention to the USPTO's recent Internet web page posting entitled "Treatment of Amendments that if Entered Would Cancel All of the Claims in an Application" (copy attached). This posting clearly states that the USPTO will deny entry of any amendment that seeks to cancel all claims without presenting new or substitute claims. Should Applicants be unsuccessful in the previous sections in demonstrating that the instant Application is entitled to the 20 June 2001 filing date, Applicants see no legal reason why this policy should not be applied in the instant case to accord the '217 Application a 20 June 2001 filing date.

V. CONCLUSION

Applicants request reconsideration of the Decision dismissing Applicant's Petition. The Decision contradicts the USPTO past actions and the applicable rules, laws, and procedures. The 217 Application complies with all USPTO rules and procedures and should be granted a filing date of 20 June 2001, consistent with the USPTO's present policies and procedures.

Respectfully submitted,



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Dated: 11 January 2002

Attorneys for Applicants

Number: EJ116539786
Date of Deposit: 22nd 2001

I hereby certify that this paper or fee is being deposited with the United States Postal Service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231

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PATENT
Attorney Docket No.: DB000575-012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Keeth, et al.)	Examiner:	Not yet assigned
Serial No.:	09/885,217)	Art Unit:	Not yet assigned
Filed:	20 June 2001)		
Entitled:	256 MEG DYNAMIC RANDOM ACCESS MEMORY			

PETITION TO GRANT FILING DATE

Applicants petition the Commissioner to accord the above-identified application ("217 application") a filing date of 20 June 2001. On 20 June 2001, the '217 application was filed with all necessary parts, including at least one claim.

In the alternative, Applicants request that the '217 application be accorded a filing date as of the date that this petition and second preliminary amendment were filed.

Finally, Applicants hereby petition the Commissioner to accept the proof, as outlined below, that page 29 of the specification was submitted with the '217 application and to refund the accompanying petition fee of \$130 submitted in accordance with 37 C.F.R. 1.117(h).

I. APPLICATION FILING DATE

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A. Introduction

Applicants petition the Commissioner to accord to the '217 application a filing date of 20 June 2001. It was on this date that the application was filed via Express Mail Post Office to Addressee with all necessary parts, including nineteen (19) claims.

B. Argument

The '217 application was filed on 20 June 2001 as is evidenced by the copy of the Express Mail label attached hereto as Exhibit A. This application was filed as a divisional of application serial number 09/620,606 ("606 application"). The '606 application was a divisional of application 08/916,692 ("692 application"). The '692 application was filed containing claims 1-80. The '606 application was filed with a preliminary amendment, which added claims 81-465, as can be seen in Exhibit B (a copy of the preliminary amendment that was filed with the '606 application.)

The '217 application was filed with a copy of the specification from the original application (the '692 application) and a preliminary amendment. The preliminary amendment filed in the '217 application cancelled claims 1-222, 238-246, and 251-465. Thus, the '217 application was filed with nineteen (19) claims. These were the remaining claims, numbers 223-237 and 247-250, from the preliminary amendment filed in the parent case (the '606 application).

A copy of the preliminary amendment from the '692 application was inadvertently omitted from the '217 application. Applicants rely on the text printed on the Utility Patent Application Transmittal (Exhibit C) stating, "For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered

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a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference." Applicants submitted a copy of the oath that was filed in the original application. This is evidence by the Box 5b that has been checked on the Utility Patent Application Transmittal (Exhibit C). An additional copy of this declaration is filed with this petition as Exhibit D. Thus, Applicants complied with this statement. The Preliminary Amendment filed with the '606 application should be considered as part of the '217 application, otherwise, the preliminary amendment filed in the '217 application does not make sense.

C. Conclusion

Applicants complied with the provision on the Utility Patent Application Transmittal that incorporated the entire disclosure of the prior application. The prior application contained 465 claims. Applicants filed the present application with a preliminary amendment canceling all but nineteen (19) of the claims. Therefore, Applicants filed an application on 20 June 2001 that complied by 35 U.S.C. 112, in that the application contained at least one claim. For the foregoing reasons, Applicants request that the Commissioner grant this application the filing date 20 June 2001, which corresponds to the filing date of the application as evidenced by the Express Mail label.

II. ALTERNATIVE FILING DATE

In the alternative, Applicants request that the Commissioner grant this application a filing date as of the mailing date of this petition. This petition contains a second preliminary amendment, which presents claims for examination. This second preliminary amendment places the application in compliance with 35 U.S.C. 112 as of the date of the second preliminary amendment's filing.

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III. PAGE 29 OF SPECIFICATION

Applicants contend that the above-identified application was filed with page 29. Applicants respectfully direct Commissioners attention to Exhibits C and E (the Utility Patent Transmittal Form and the return receipt postcard). Both Exhibits state that this application was filed with 232 pages of specification; page 29 was one of these 232 pages. Applicants additionally assert that each page of the specification was visually checked prior to mailing to insure that every page was there. Applicants respectfully contend that page 29 was included in the above-identified application. Applicants have included a copy of page 29 with this petition.

Applicants contend that this evidence is sufficient to prove that 232 pages of specification were submitted with the application and that page 29 was one of the 232 submitted pages.

IV. NO NEW OATH IS NECESSARY

Applicants hereby petition the Commissioner under 37 C.F.R. 1.63(d)(1) to withdraw the request for submission of an oath or declaration.

A. Introduction

Applicants submitted a copy of the declaration from the prior original application with the filing of the present divisional application in compliance with 37 C.F.R. 1.63(d)(1). No new oath is needed for the claims that are included in the preliminary amendment, which was filed with the '217 application. This preliminary amendment did not add any new claims. It merely cancelled claims from the parent application. Hence, this preliminary amendment is covered by the oath that was filed in the parent application, a copy of which was filed with this application.

Additionally, no new oath is needed for page 29. Page 29 was submitted with the other 367 drawings on 20 June 2001. A copy of the oath from the prior original application was submitted at that same time. This oath covered all 367 pages, including page 29. Therefore, the present application was filed on 20 June 2001 with an oath that covered the application and does not need a new oath or declaration.

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Furthermore, page 29 was incorporated by reference, as it was part of the disclosure of the prior application. Applicants rely on the text printed on the Utility Patent Application Transmittal (Exhibit C) stating, "For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference." Applicants submitted a copy of the oath that was filed in the original application. This is evidence by the Box 5b that has been checked on the Utility Patent Application Transmittal (Exhibit C). An additional copy of this declaration is filed with this petition as Exhibit D. Thus, Applicants complied with this statement. Page 29, which was also filed with the '606 application, should be considered as part of the '217 application as filed on 20 June 2001.

V. CONCLUSION

Applicants petition the Commissioner to accord the above-identified application ("217 application") a filing date of 20 June 2001. On 20 June 2001, the '217 application was filed with all necessary parts, including at least one claim.

In the alternative, Applicants request that the '217 application be accorded a filing date as of the date that this petition was filed.

Additionally, Applicants hereby petition the Commissioner to accept the proof, as outlined above, that page 29 of the specification was submitted with the '217 application and to refund the accompanying petition fee of \$130 submitted in accordance with 37 C.F.R. 1.117(h).

Respectfully submitted



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Dated: 22 August 2001

Attorneys for Applicants



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Paper No. 4

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OFFICE OF PETITIONS

In re Application of :
Keeth et al. : DECISION DISMISSING
Application No. 09/885,217 : PETITION
Filed: 22 August, 2001 :
Attorney Docket No. DB000575-012 : :

This is a decision on the petition, filed on 22 August, 2001, to accord the above-identified application a filing date of 20 June, 2001, with a complete specification, including at least one claim, as a part of the original disclosure.

The petition is dismissed.

On 20 June, 2001, a bundle of papers was deposited in the USPTO, and was assigned Application No. 09/885,217. The papers consisted of, *inter alia*, 232 pages of specification, including Claims 1-80, a signed declaration, and a preliminary amendment, which, *inter alia*, canceled Claims 1-222, 238-246, and 251-465. Accordingly, on 6 August, 2001, Initial Patent Examination Division mailed a Notice of Incomplete Nonprovisional Application, stating that the application had not been accorded a filing date because the specification did not include at least one claim and that Page 29 appeared to have been omitted from the specification.

In response, on 22 August, 2001, the present petition was filed. Petitioners assert that the application as filed contained 19 claims. Petitioners state that the present application is a division of Application No. 09/620,626 which is a division of Application No. 08/916,692. Application No. 08/916,692 as filed contained Claims 1-80. Application No. 09/620,626 was filed with a preliminary amendment adding Claims 81-465. Petitioners point to a statement on the transmittal letter for Application No. 09/885,217 which incorporates by references the entire disclosure

of the prior application No. 09/620,626, as evidence that the preliminary amendment adding Claims 81-465 was incorporated into the present application, and that the application as filed with the preliminary amendment canceling Claims 1-222, 238-246, and 251-465 included 19 claims.

Petitioners' assertion is not well taken. The declaration filed in the present application is the declaration filed in Application No. 08/916,692 which was filed prior to the filing of Application No. 09/620,626 and the amendment thereto adding Claims 81-465. The declaration does not execute a subsequently filed amendment. What was incorporated, therefore, is only the specification, claims, and drawings from Application No. 08/916,692. Therefore, the Notice correctly stated that the specification did not include at least one claim. The application is accorded a filing date of 22 August, 2001, the date that the preliminary amendment filed in Application No. 09/620,626 adding Claims 81-465, was filed in the present application.

In view of the above, petitioners' assertion that Page 29 of the specification (description and claims) was filed on 20 June, 2001, is moot. The application, including Page 29, will be accorded a filing date of 22 August, 2001.

It is noted that since prior Application No. 09/620,626 had not issued as of 22 August, 2001, copendency exists between it and the present application.

As the present petition was not necessitated by Office error, the petition fee will not be refunded.

The application is being returned to the Office of Initial Patent Examination for reprocessing with a filing date of 22 August, 2001, and an indication on the bib-data sheet that 19 claims were present on filing.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Douglas I. Wood at (703) 308-6918.


Beverly M. Flanagan
Supervisory Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Treatment of Amendments that if Entered Would Cancel All of the Claims in an Application

Office of Patent Legal Administration << Pre-OG Notices << Treatment of Amendments that if Entered Would Cancel All of the Claims in an Application

Before June of 1998, it was the practice of the United States Patent and Trademark Office (USPTO) to treat an application filed with an amendment (preliminary amendment) canceling all of the claims and presenting no new or substitute claims by denying entry of the amendment. See **Manual of Patent Examining Procedure §§ 711.01 and 714.19** (7th ed: 1998) (MPEP). In **Baxter Int'l Inc. v. McGaw Inc.**, 149 F.3d 1321, 47 USPQ2d 1225 (Fed. Cir. 1998), the U.S. Court of Appeals for the Federal Circuit (Federal Circuit) held that a divisional application that included instructions to cancel all of the claims in the specification, but did not present any new claims, did not contain at least one claim as required by 35 U.S.C. § 112, ¶ 2, and, thus was not entitled to a filing date under 35 U.S.C. § 111(a) until the date an amendment including at least one claim was filed in the application. Following **Baxter**, the USPTO changed its practice and no longer accorded a filing date to any application that was accompanied by a preliminary amendment which cancels all claims and fails to simultaneously submit any new claims. See **Any Application Filed With Instructions to Cancel All of the Claims in the Application is Not Entitled to a Filing Date**, 1216 Off. Gaz. Pat. Office 46 (Nov. 10, 1998).

Recently, in **Exxon Corp. v. Phillips Petroleum Co.**, 265 F.3d 1249, 60 USPQ2d 1368 (Fed. Cir. 2001), the Federal Circuit affirmed that the USPTO may refuse to enter an improper amendment that would cancel all of the claims in an application to avert harm (loss of a filing date) to an applicant. The Federal Circuit distinguished its decision in **Baxter** since in **Baxter** the USPTO did enter the amendment that canceled all of the claims in the application (contrary to the provisions of MPEP §§ 711.01 and 714.19 then in effect), thus resulting in the application not being entitled to a filing date. In contrast, in **Exxon** the USPTO refused to enter the amendment and thus the claims were never canceled.

Consistent with **Exxon** and MPEP §§ 711.01 and 714.19, the USPTO will deny entry of any amendment (whether submitted with the filing of the application or after the filing date of the application) that seeks cancellation of all claims but does not present any new or substitute claims. For fee calculation purposes, however, the USPTO will treat such an application as containing a single claim.

The USPTO plans to codify this modification of the USPTO's current practice in the rules of practice. While some period of time will elapse before any final rule change can be promulgated, this modification of the USPTO's current practice (which is also consistent with the current rules of practice) is effective immediately. In addition, the provision in MPEP § 601.01(e) concerning the treatment of a nonprovisional application accompanied by a preliminary amendment which cancels all claims and fails to simultaneously submit any new claim(s) will be revised consistent with this notice in due course.

Inquiries concerning this notice may be addressed to Fred A. Silverberg, Senior Legal Advisor, Office of Patent Legal Administration, at 703-305-8986.

Date: January 9, 2002

Signed: /s/

Stephen G. Kunin
Deputy Commissioner
for Patent Examination Policy

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OFFICE OF PETITIONS

In re Application of :
Keeth et al. : DECISION DISMISSING
Application No. 09/885,217 : PETITION
Filed: 22 August, 2001 :
Attorney Docket No. DB000575-012 :
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In response, on 22 August, 2001, the present petition was filed. Petitioners assert that the application as filed contained 19 claims. Petitioners state that the present application is a division of Application No. 09/620,626 which is a division of Application No. 08/916,692. Application No. 08/916,692 as filed contained Claims 1-80. Application No. 09/620,626 was filed with a preliminary amendment adding Claims 81-465. Petitioners point to a statement on the transmittal letter for Application No. 09/885,217 which incorporates by references the entire disclosure

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Application No. 09/885,217

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of the prior application No. 09/620,626, as evidence that the preliminary amendment adding Claims 81-465 was incorporated into the present application, and that the application as filed with the preliminary amendment canceling Claims 1-222, 238-246, and 251-465 included 19 claims.

Petitioners' assertion is not well taken. The declaration filed in the present application is the declaration filed in Application No. 08/916,692 which was filed prior to the filing of Application No. 09/620,626 and the amendment thereto adding Claims 81-465. The declaration does not execute a subsequently-filed amendment. What was incorporated, therefore, is only the specification, claims, and drawings from Application No. 08/916,692. Therefore, the Notice correctly stated that the specification did not include at least one claim. The application is accorded a filing date of 22 August, 2001, the date that the preliminary amendment filed in Application No. 09/620,626 adding Claims 81-465, was filed in the present application.

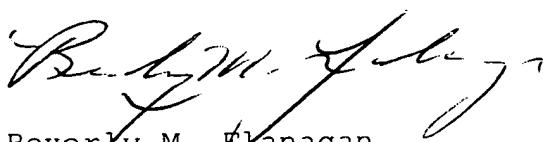
In view of the above, petitioners' assertion that Page 29 of the specification (description and claims) was filed on 20 June, 2001, is moot. The application, including Page 29, will be accorded a filing date of 22 August, 2001.

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Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy